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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/552,459

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Luca Turin

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MILES & STOCKBRIDGE PC  
1751 PINNACLE DRIVE  
SUITE 500  
MCLEAN, VA 22102-3833

EXAMINER

SOLOLA, TAOFIQ A

ART UNIT

PAPER NUMBER

1625

NOTIFICATION DATE

DELIVERY MODE

03/26/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ipdocketing@milesstockbridge.com  
sstiles@milesstockbridge.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/552,459	<b>Applicant(s)</b> TURIN, LUCA	
	<b>Examiner</b> Taofiq A. Solola	<b>Art Unit</b> 1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 07 January 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) 22-24, 26, 27 and 29-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 22-24, 26-27, 29-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

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Claims 22-24, 26-27, 29-33 are pending in this application.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 29-30, 32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification lacks adequate support for the claims. The percent weight composition in the claims is not supported on page 6, line 5, of the specification as asserted by applicant. By deleting the claims the rejection would be overcome.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 24, 26-27, are rejected under 35 U.S.C. 102(b) as being anticipated by Boggle et al., Monatshefte fur Chemie (1988), Vol. 119, pp. 945-951.

Boggle et al., disclose benzo[4,5]thieno[3,2b]pyran-2-one (compound 1c) and composition thereof at pages 946; 947, lines 12-13; 948, line 19. The instant compounds and compositions are claimed with their intended use as perfumes. Under the US patent practice

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intended use is not a limitation of a compound or product. *In re Hack*, 114USPQ 161 (CCPA, 1957); *In re Craig*, 90 USPQ 33 (CCPA, 1951); *In re Brenner*, 82 USPQ 49 (CCPA, 1949). The new utility is inherent in the compound.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 22-24, 26-27, 29-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boggle et al., Monatshefte fur Chemie (1988), Vol. 119, pp. 945-951.

Applicant claims perfuming compositions of benzo[4,5]thieno[3,2b]pyran-2-one, wherein the compositions comprise variable amounts of the active compound or additional active compound.

#### *Determination of the scope and content of the prior art (MPEP 2141.01)*

Boggle et al., teach benzo[4,5]thieno[3,2b]pyran-2-one (compound Ic) and composition thereof at pages 946; 947, lines 12-13; 948, line 19. The composition comprises additional active compounds.

#### *Ascertainment of the difference between the prior art and the claims (MPEP 2141.02)*

The difference between the instant invention and that of Boggle et al., is that applicant claims compositions with intended use, and variable amounts of the active compounds.

#### *Finding of prima facie obviousness---rational and motivation (MPEP 2142.2413)*

However, it is well known in the cosmetics industries to use variable amounts of the active compounds. For example, see US 3,779,932; 3,947,574; 4,055,634 and 4,708,821.

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Under the US patent practice intended use is not a limitation of a compound or product. *In re Hack*, 114USPQ 161 (CCPA, 1957); *In re Craig*, 90 USPQ 33 (CCPA, 1951); *In re Brenner*, 82 USPQ 49 (CCPA, 1949). Therefore, the instant invention is prima facie obvious from the teaching of Boggle et al. One of ordinary skill in the art would have known to make compositions having variable amounts of the active compound at the time the invention was made. The motivation is from the well-known practice in the cosmetics industries of doing such.

Also, the addition of an inert carrier to a non-patentable compound is unpatentable, *In re Best*, 195 USPQ 430 (CCPA 1977), and changing the amounts of the active compound in a composition does not rise to the level of invention under the US patent practice. If applicant discovered a new use for the compound of Boggle et al, applicant is entitled to apply for such.

### ***Response to Argument***

Applicant's arguments filed 1/7/08 have been fully considered but they are not persuasive. Applicant argues Buggle et al., fail to suggest any utility for the compound, and that it is an intermediate. This is not persuasive because the compound is one of many products by Buggle et al., some of which are used to produce other compounds. See Introduction, lines 5-6, and Spectroscopic data in table 1. According to *Lalu*, 223 USPQ 1257 (CAFC, 1984), the use of a compound as intermediate is not sufficient motivation to support structural modification under 35 USC 103. In the instant, the compound of Buggle et al., is not modified by applicant. The compound is in public domain before the instant invention was made and therefore, its composition is not subject to patentability. Applicant cannot claim the composition of a compound that is not applicant's invention.

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**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taofiq A. Solola, PhD. JD., whose telephone number is (571) 272-0709.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres, can be reached on (571) 272-0867. The fax phone number for this Group is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

/Taofiq A. Solola/

Primary Examiner, 1625

March 17, 2008

